

REMARKS

In the Office Action¹ mailed September 10, 2007, claims 1-4, 6, 8-15, 17, 19-25, 29 and 30 were rejected under 35 U.S.C. §102(e) as being anticipated by Pub. No. US 2004/0225507, by Smith et al. (hereinafter "*Smith*"). Also, claims 27 and 28 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Smith* and claims 5, 7, 16, 18 and 26 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Smith* and further in view of Pub. No. US 2002/0019759 by Arunapuram et al. (hereinafter "*Arunapuram*"). With this amendment, claim 28 has been cancelled. Claims 1-27 and 29-30 are pending in the application of which claims 1, 12, 23-25 and 30 are independent.

Specification

The amendment to the Specification corrects three (3) grammatical errors. No new matter is introduced by the foregoing amendments.

Claims

By this Amendment, Applicant also amends independent claim 1, 12, 23, 24, 25 and 30 and dependant claims 9-11, 17, 20-22 and 27 to more appropriately define Applicant's invention.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

35 U.S.C. §102 Rejection

In the Office Action, claims 1-4, 6, 8-15, 17, 19-25, 29 and 30 were rejected under 35 U.S.C. §102 as being anticipated by *Smith*. To properly establish that a prior art reference anticipates a claimed invention under 35 U.S.C. §102, each and every element of the claims in issue must be found, either expressly described or under principles of inherency, in the single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim."

See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Applicant respectfully traverses the rejection of claims 1-4, 6, 8-15, 17, 19-25, 29 and 30 since *Smith* fails to teach each and every element of these claims. For example, *Smith* does not disclose at least the following element found in claim 1: "determining a set of trips based on a set of geographic routes, transportation service provider information, and scheduling information." The Office Action cites *Smith*'s para. 0024 and 0025 to demonstrate that *Smith* discloses "ship schedules from each supplier are received, in order to determine the delivery date," and asserts that "ship schedules" are considered to be a set of trips. See Office Action at 2. However, nowhere in *Smith* para. 0024 or 0025, or elsewhere in *Smith*, is there a suggestion that "ship schedules" have a geographic feature. There is no suggestion of determining trips **based on a set of geographic routes** as recited in claim 1 (emphasis added).

Smith's para. 0024 discloses a delivery management system comprising a delivery date calculator and an electronic manifest which comprises ship schedules of each respective supplier, ship schedules for each delivery agent, capacity schedules for each delivery agent, special information from each delivery agent, delivery zones for each delivery agent, zip codes groups for respective delivery zone, and work unit data from each supplier. In addition, *Smith* para. 0025 provides additional detail about the supplier ship schedule and provides an exemplary "ship schedule." However, nowhere in *Smith* at 0024 or at 0025 or elsewhere is there disclosure of the route that the supplier would take or disclosure of selecting "a set of trips based on a set of geographic routes." The scheduling systems and methods described in the Applicant's application take into account route information to determine one or more trips for delivery of the goods. See Spec. at 7. However, nowhere in *Smith's* para. 0024-0025, or elsewhere in *Smith*, is there a suggestion of identifying a set of routes. As such, the cited portions of *Smith* cannot teach or suggest "determining a set of trips based on a set of geographic routes, transportation service provider information, and scheduling information," as recited in claim 1.

Moreover, *Smith* does not disclose at least the following element found in claim 1: "selecting a source location for the good based on the availability date of the good at the source location." The Office Action cites *Smith's* para. 0020 to demonstrate that *Smith* discloses, "determining which supplier is associated with the order," therefore the examine considers this to be selecting the source location of the good. See Office Action at 2. However, nowhere in *Smith* para. 0020, or elsewhere in *Smith*, is there a

suggestion that a source location is selected **based on the availability date** of the good (emphasis added). *Smith* discloses that a supplier is selected based on zip code and brand of the good. See *Smith* at para. 0031. Therefore, *Smith* cannot teach or suggest "selecting a source location for the good based on the availability date of the good at the source location," as recited in claim 1.

For at least these reasons, claim 1 is allowable under 35 U.S.C. §102. For at least the reasons stated above with respect to claim 1, which independent claims 12, 23, 24, 25 and 30, though of different scope from claim 1, recite similar elements and were rejected under the same rationale, are allowable under 35 U.S.C. §102. See Office Action at 2. Additionally, claims 2-4, 6, 8-11, 13-15, 17, 19-22, and 29 are also allowable at least since they depend directly or indirectly from claims 1, 12 and 25.

For these reasons, Applicant's claims are patentably distinct from *Smith*. Applicant respectfully requests the rejection under 35 U.S.C. §102 of independent claims 1, 12, 23, 24, 25, 30 and claims 2-4, 6, 8-11, 13-15, 17, 19-22, 29 which depend therefrom, to be withdrawn.

Rejection under 35 U.S.C. §103

Applicant respectfully traverses the rejection of claim 27 under 35 U.S.C. §103(a) as being unpatentable over *Smith* and the rejection of claims 5, 7, 16, 18, and 26 under 35 U.S.C. §103(a) as being unpatentable over *Smith* in view of *Arunapuram*.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections

on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art." M.P.E.P. § 2143.01(III) (emphasis in original). "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. M.P.E.P. § 2141.02(I) (emphases in original).

"[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

Here, a *prima facie* case of obviousness has not been established because the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Examiner has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

Turning first to claim 27, a *prima facie* case of obviousness has not been established because the claimed invention is not obvious as a whole. The rejection of claim 27 was based on official notice that rush orders are well known and therefore, it would have been obvious to modify *Smith* to include rush orders. *Smith* does not teach, disclose or suggest the feature recited in claim 27 of planning a rush order. The Office Action suggests the same conclusion. See Office Action at 4. Claim 27 depends from claim 25, and thus include all the elements and limitations thereof. As set forth above with respect to claim 1, which recite similar elements of claim 25, the feature "determining a set of trips based on a set of geographic routes, transportation service provider information, and scheduling information" is not found in *Smith*. Therefore, whether or not rush orders comprise an obvious feature, incorporating rush orders into *Smith* would not result in the invention recited in claim 27 as a whole.

Now turning to claims 5 and 7, a *prima facie* case of obviousness has not been established because the claimed invention is not obvious as a whole. Claims 5 and 7 recite making selections based on dangerous goods and cost information, respectively. The Office Action asserted it would have been obvious to one having ordinary skill in the art at the time the invention was made "to modify *Smith*, to have the optimal trip selected based on criteria, such as hazardous material and cost, as disclosed by *Arunapuram*." See Office Action at 4. However, incorporating hazardous material and cost into *Smith* would not result in the invention recited in claims 5 and 7 as a whole. Claims 5 and 7 depend from claim 1 and thus include all the elements and limitations thereof. As set forth above with respect to claim 1, the feature, "selecting a source

location for the good based on the availability date of the good at the source location", is not found in *Smith*. *Arunapuram* also does not teach, disclose or suggest the feature "selecting a source location for the good based on the availability date of the good at the source location," featured in claim 1. The system in *Arunapuram* manages transportation operations by processing information related to the transportation of a good and produces transportation solutions based on this information. See *Arunapuram* at 16. However, nowhere in *Arunapuram* is there any suggestion of selecting a source location. Therefore, whether or not selecting a trip based on dangerous goods or cost information was disclosed in *Arunapuram*, incorporating these features into *Smith* would not result in the invention recited in claims 5 and 7 as a whole.

For at least this reason, a *prima facie* case of obviousness with respect to claims 5 and 7 have not been proved. The rejection of claims 5 and 7 under 35 U.S.C. §103(a) as being obvious from *Smith* in view of *Arunapuram* is thus improper and should be withdrawn.

For at least the reasons noted above, claims 16, 18 and 26, which recite similar elements rejected under the same rationale, are allowable under 35 U.S.C. §103(a). See Office Action at 4.

In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this

Amendment, the reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: _____

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By: _____

Maura K. Moran

Maura K. Moran
Reg. No. 31,859